

REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of reasons that follow.

Status of Claims:

No claims are currently being canceled.

Claim 2 is currently being amended.

Claims 33 and 34 are currently being added.

This amendment and reply adds and amends claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claims remain under examination in the application, is presented, with an appropriate defined status identifier.

After adding and amending the claims as set forth above, claims 1-5, 7, 8, 13, 15, 17, 18, 20, 21, 23, 24 and 26-34 are now pending in this application.

Indication of Allowable Subject Matter:

Applicants appreciate the indication of allowable subject matter made in the Office Action with respect to claims 27 and 31.

Claim Rejections – Prior Art:

In the Office Action, claims 1-5, 7, 8, 17, 20, 23, 28 and 32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,377,804 to Lintulampi in view of U.S. Patent No. 6,424,638 to Ray and U.S. Patent No. 5,594,731 to Reissner; claims 13, 15, 18, 19, 21, 24 and 26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lintulampi in view of Ray and Reissner and further in view of U.S. Patent Publication No. 2001/0046863 to Rinne; and claim 29 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Lintulampi in view of Ray and Reissner and further in view of U.S. Patent No. 7,200,110 to Burns. These rejections are traversed with respect to the presently pending claims under rejection, for at least the reasons given below.

The invention according to claim 1 is directed to a method of establishing UMTS communication between a User Equipment (UE) and a Universal Mobile Telecommunications System (UMTS) network, in which UTRAN parameters are forwarded to the UE via a GSM-type network, and in which the UTRAN parameters comprise a list of at least one access node. The claimed UTRAN parameter that comprise a list of at least one access node, which are forwarded to the UE via the GSM-type network, are not disclosed, taught or suggested by Lintulampi.

The Office Action recognizes this deficiency in Lintulampi, and relies on Ray and Reissner for providing the missing teachings in Lintulampi. In particular, the Office Action asserts that column 5, lines 32-67 of Ray teaches a list of at least one node, and that it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Ray into the system of Lintulampi in order to provide a handover of a call between different types of systems as Ray suggests. Ray does not disclose, teach or suggest that UTRAN parameters are forwarded to the UE, wherein those UTRAN parameters comprise a list of at least one access node, as explicitly recited in independent claim 1.

In particular, claim 1 recites: in the UE, using the list (of at least one access node) to switch communications with the UE from the GSM-type network to the UMTS network. Certainly, Ray may disclose a “list” of access nodes. However, Ray and the presently pending claims are different in the use of the “list”. Specifically, the “list” of Ray is a list in order that an MSC identifies a BS to be connected, and is not a list of access nodes used in the UE. Even if the teaching of Ray was combined with the system of Lintulampi, the list as taught by Ray is not used in a user equipment (e.g., a mobile station). If anything, the list of Ray is only used in any of a “GSM-op:GSM-CN” and a “UMTS-op:GSM-CN” of Lintulampi, which corresponds to the MSC of Ray. Accordingly, the list as specifically recited in claim 1 is quite different than that list of Ray, and certainly the use of the list as specifically recited in claim 1 is not taught or suggested by the combination of Lintulampi and Ray.

Column 5, lines 32-67 of Ray describes that identity information can be used instead of location information for each base station, whereby the identity information includes a list of all mobile switching centers (MSCs) 14a and 14b for each type of wireless system 350 and

360 within an Internet Gatekeeper 320 area. However, unlike the present invention as recited in claim 1 in which the UTRAN parameters that comprise a list of at least one access node is forwarded to a User Equipment (UE) via a GSM-type network, the identity information in the system of Ray is utilized by an Internet Gatekeeper 320, which is the entity that utilizes such access node information to determine which wireless system (350 or 360) to connect a call to a user equipment. Clearly, the Internet Gatekeeper 320 of Ray is not the same as the User Equipment (UE) of claim 1, whereby the User Equipment (UE) of claim 1 is a device used by a User to make or answer a call, which is clearly not the case with Ray's Internet Gatekeeper 320, which is a network device that is not accessed by a user to make or answer a call.

In addition, Ray discloses that the GSM MSC 14c receives the list 355 from the Internet Gatekeeper 320 (see column 5, line 63 to column 6, line 6 and Figure 4 of Ray) and determines the identity of the associated MSC 14b by using the list 355 (see column 6, lines 22 to 24 and Figure 4 of Ray). However, Ray does not disclose, teach or suggest that the GSM MSC 14a forwards the list 355 to the MS 20a.

The Office Action appears to recognize this deficiency in Ray, and relies on Reissner for allegedly teaching the use of a list of at least one node at a UE. However, as described in column 10, line 59 to column 11, line 19 of Reissner, a mobile node creates a table of Access Points (APs) by associating an AP every time it hears that AP's beacon. Thus, the creation of the table of APs by a wireless node in the system of Reissner is not created based on UTRAN parameters forwarded to the wireless node by a GSM-type network.

Accordingly, the combination of Reissner and Ray does not disclose, teach or suggest that UTRAN parameters are forwarded to the UE and comprise a list of at least one access node that are used by the UE to switch communications with the UE from a GSM-type network to a UMTS network, as explicitly recited in presently pending independent claim 1. Therefore, Reissner and Ray do not provide the missing teachings in Lintulampi.

The combination of Lintulampi and Ray and Reissner would, at best, teach the sending of UTRAN parameters to a UE, whereby a list of at least one access node would not be sent to the UE, but rather it would be sent to an Internet Gatekeeper 320, which is not accessible by a user, and whereby the UE would create a list of at least one access node by overhearing beacons output by various access points via wireless means. The

combined system of Lintulampi and Ray and Reissner would not provide the list of at least one access node to the UE, since it's system is constructed such that the access node information is best handled by the Internet Gatekeeper 320 (as taught by Ray), and since Reissner describes that the UE creates its own list on its own, and to argue otherwise goes against the explicit disclosure of Ray and Reissner.

Thus, the combination of Lintulampi and Ray and Reissner would teach, at best, the sending of some UTRAN parameters to the UE, but it would not teach or suggest the sending of at least one access node to the UE, since that information would be sent to the Internet Gatekeeper, which is a better device for utilizing such information (at least based on the disclosure of Ray), and since Reissner teaches that the UE itself creates its own list of access nodes by overhearing beacons output by access nodes.

Presently pending independent claims 7, 8, 17, 20 and 23 recite similar features to those discussed above with respect to independent claim 1, and thus those independent claims are also patentable over the cited art of record.

The dependent claims under rejection are patentable over the cited art of record for the specific features recited in those claims, as well as due to their respective dependencies on one of the presently pending independent claims, the patentability of which is discussed above.

For example, dependent claim 30 recites that the UTRAN parameter information output from the UMTS network tunnels through the GSM-type network without being interpreted or processed in any manner by the GSM-type network. On page 6 of the Office Action, it asserts that Reissner teaches that UTRAN parameter information output from the UMTS network tunnel through the GSM type network without being interpreted or processed in any manner by the GSM type network, but it does not provide a specifics as where such features can be found (e.g., column and line numbers, and/or figure numbers) in Reissner. Such features do not appear to be taught or suggested by Reissner, and certainly not in column 9, lines 9-19 of Reissner (the portion of Reissner applied against claim 1).

Thus, clarification as to the rejection of claim 30 based in part on the disclosure of Reissner is respectfully requested.

Claim 2 now recites a step of allocating, by the RNC, UTRAN resources for a communication by the UE using the UMTS network, whereby such features are not taught or suggested by the cited art of record, when taken as a whole.

New Claims:

New claims 33 and 34 recite similar features as added to claim 2, whereby those claims also patentably distinguish over the cited art of record, when taken as a whole.

Conclusion:

Since all of the issues raised in the Office Action have been addressed in this Amendment and Reply, Applicants believe that the present application is now in condition for allowance, and an early indication of allowance is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorize payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date November 12, 2009 By Phillip J. Articola

FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 945-6014
Facsimile: (202) 672-5399

George C. Beck
Registration No. 38,072
Phillip J. Articola
Registration No. 38,819